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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,751	08/28/2001	Yasuhiro Torimaru	108391-00019	3839

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EXAMINER

CONNOLLY, MARK A

ART UNIT

PAPER NUMBER

2115

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/939,751

Applicant(s)

TORIMARU ET AL.

Examiner

Mark Connolly

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 11-22 is/are rejected.
- 7) ☐ Claim(s) 4 and 6-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-22 have been presented for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 12, 14, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matter et al [Matter] US Pat No 5392437.
4. Referring to claim 1, Matter teaches the invention substantially including:
  - a. an oscillation circuit which oscillates and outputs an oscillation signal [fig. 3 and col. 8 lines 19-31]. The internal bus controller (201) is interpreted as the oscillation circuit and the clock signals NPXPH1 and NPXPH2 on line (210) are both interpreted as an oscillation signal.
  - b. a wakeup terminal that always receives a wakeup signal [fig. 3 and col. 8 lines 13-31]. The FCLKEN signal on line is interpreted as a wakeup signal.
  - c. a clock control circuit which controls said oscillation circuit so to stop the oscillation, and based on the wakeup signal received through said wakeup terminal controls said oscillation circuit so as to restart the oscillation [fig. 3 and col. 8 lines 19-31]. The internal bus controller (201) is also interpreted as the clock control circuit since it controls clocks NPXPH1 and NPXPH2.

Art Unit: 2115

5. Referring to claim 2, because the wakeup signal causes the oscillation signal to restart from a stopped state, it is obvious that the wakeup signal could be nullified while the oscillation signal is output since the oscillation signal would not be disabled and therefore would not have to be restarted.

6. Referring to claim 3, Matter teaches the invention substantially including:

d. an oscillation circuit which oscillates and outputs an oscillation signal and stops the oscillation during a period in which it receives an oscillation stop signal [col. 7 lines 44-46 and col. 8 lines 19-31].

e. a wakeup terminal that receives a wakeup signal [col. 8 lines 19-31].

f. a clock control circuit which receives the wakeup signal, and stops output of the oscillation stop signal based on the wakeup signal [col. 7 lines 44-46 and col. 8 lines 19-31].

Although FCLKEN is taught as causing the oscillation signal to both stop and restart, it is not taught specifically how it controls the operation of the oscillation signal. In particular, Matter only teaches that a wakeup signal is supplied to the oscillation circuit, which causes the oscillation signal to restart or become disabled. Because the oscillation circuit outputs the oscillation signal based on the FCLKEN, it is interpreted that the FCLKEN signal is used to generate a stop signal which controls the actual generation of the oscillation signal. It is further interpreted that when the FCLKEN signal indicates that a restart of the oscillation signal should occur, the generation of the stop signal will be ceased.

7. Referring to claim 5, this is rejected on the same basis as set forth hereinabove.

8. Referring to claims 12, 14, 18 and 19, these are rejected on the same basis as set forth hereinabove.

9. Claims 11, 13, 15-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matter as applied to claims 1-3, 5, 12, 14, 18-19 above, and further in view of Stansell US Pat No 5886582.

10. Referring to claim 11, although Matter teaches stopping the oscillation signal, it is not explicitly taught to stop the oscillation signal based on a condition of the oscillation signal. Stansell explicitly teaches monitoring an output clock and disabling it when the clock is unstable [col. 2 lines 51-65]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings in Stansell into the Matter system because it will provide a means to prevent any errors or prevent the Matter system from entering an unstable state due to an unstable clock.

11. Referring to claims 13 and 15, these are rejected on the same basis as set forth hereinabove.

12. Referring to claim 16, this is rejected on the same basis as set forth hereinabove. In addition, Stansell teaches that the clock is disabled during a time when the clock is either unstable or invalid [col. 2 lines 59-63]. This Furthermore, because the wakeup signal restarts the oscillation signal it is interpreted that the wakeup signal would stop the output of the stop signal.

13. Referring to claim 17, Stansell teaches stopping the clock signal when the clock signal is invalid [col. 2 lines 61-63].

14. Referring to claims 20-22, these are rejected on the same basis as set forth hereinabove.

***Allowable Subject Matter***

15. Claims 4 and 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments filed 7/20/05 have been fully considered but they are not persuasive.

17. In the remarks, the applicants argued in substance that (1) Matter does not receive the wakeup signal at the wakeup terminal from *outside the microcomputer* (2) Stansell does not teach the claimed invention under 35 U.S.C. §102 (3) combination of Matter and Stansell is improper because there is no suggestion or motivation in the references to do so.

18. In response to argument (1), the applicants arguments repeatedly argue that independent claims 1, 3, 12, 14, 16, 18, 19 and 21 recite that the wakeup signal received by the wakeup terminal is from “*outside the microcomputer*” (emphasis added.) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., receiving the wakeup signal from outside *the microcomputer*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Not one of the claims indicated by the applicant even suggests that the wakeup signal is received from outside *the microcomputer*. All that is claimed is that a wakeup signal is received from outside. The examiner argues that the wakeup signal received by the wakeup terminal in

Art Unit: 2115

Matter (i.e. FCLKEN received by internal bus controller 201) is received from outside wherein outside is from outside internal bus controller 201. The examiner believes that this is a fair interpretation of the claims. In fact, claims 18 and 19, which applicants argue are the same as the other independent claims with respect to the fact that they all receive the wakeup signal from outside the microcomputer (see page 2 line 19 – page 3 line 3 in the Remarks), merely recite that the wakeup terminal receives the wakeup signal from a “wakeup signal supplying unit.” This suggests that receiving a wakeup signal from a wakeup signal supplying unit qualifies as receiving a wakeup signal from outside. Again, there is no mention or indication that the wakeup signals are received from outside *the microcomputer*. The examiner argues that Matters floating point unit 202 is a wakeup signal supplying unit since it supplies FCLKEN to internal bus controller 201. The wakeup signal received by internal bus controller 201 from the wakeup signal supplying unit (i.e. floating point unit 202) is received from outside the internal bus controller 201 and therefore the interpretation is fair and rejections are appropriate.

19. In response to argument (2), applicant's arguments against the references individually, cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the applicants contention is misplaced because Stansell was not used in any 102 rejections in the previous office action.

20. In response to argument (3), the test of obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888.

Art Unit: 2115

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference."

Entire quote from *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period



Art Unit: 2115

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Connolly whose telephone number is (571) 272-3666. The examiner can normally be reached on M-F 8AM-5PM (except every first Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on (571) 272-3667. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Connolly  
Examiner  
Art Unit 2115

mc  
September 14, 2005

THOMAS LEE  
ADVISORY PATENT EXAMINER  
TECHNOLOGY CENTER